

REMARKS

I. Summary of the Examiner's Action

A. Claim Rejections

As set forth in paragraph 3 on page 2 of the June 19 Office Action, claim 43 stands rejected under 35 U.S.C. § 101 because the claimed invention is not supported by either an asserted utility or a well-established utility.

As set forth in paragraph 7 on page 5 of the June 19 Office Action, claim 43 stands rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent No. 6,594,503 B1 to Herzig *et al.* (hereinafter "Herzig" or "the Herzig patent").

As set forth in paragraph 9 on page 6 of the June 19 Office Action, claims 1, 3 – 12, 14 – 17, 22 – 23, 26 – 37 and 40 – 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Herzig patent in view of United States Patent Application Publication No. 2002/0140993 A1 to Silverbrook (hereinafter "Silverbrook" or "the Silverbrook application") and further in view of DE010158358351A1 to Schultheis (hereinafter "Schultheis").

As set forth in paragraph 10 on page 14 of the June 19 Office Action, claims 13 and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Herzig patent in view Silverbrook and Schultheis and further in view WO 99/17230 to Schlasberg (hereinafter "Schlasberg").

As set forth in paragraph 11 on page 15 of the June 19 Office Action, claims 24 – 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Herzig patent in view Silverbrook and Schultheis and further in view of United States Patent No. 6,707,581 to Browning (hereinafter “Browning”).

As set forth in paragraph 12 on page 16 of the June 19 Office Action, claim 39 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Herzig in view of Silverbrook and Schultheis and further in view of United States Patent No. 6,741,864 B2 to Wilcock et al. (hereinafter “Wilcock” or “the Wilcock patent”).

II. Applicant’s Response – Claim Rejections

A. Rejections of Claim 43

Applicant has cancelled claim 43 thereby mooted the rejections of this claim.

B. Rejections under 35 U.S.C § 103(a)

Applicant reproduces claim 1 (as amended) here as a convenience to the Examiner (emphasis added):

1. An electronic device comprising:
data reading means operable to read metadata carried by an image carrier which carries a printed image;
interpretation means operable to interpret the metadata to identify an instruction for operation of the device;

execution means operable to cause the device to execute an instruction identified by the interpretation means; and

an image system comprising:

image means operable to receive data representing an image;

metadata means operable to generate metadata able to be interpreted, by another electronic device, to identify an instruction of the electronic device to the another electronic device, and to associate the metadata with the image data; and

data output means operable to output image data and associated metadata for generating a printed image on an image carrier, wherein the printed image carried by the image carrier incorporates the metadata in a form readable by the another electronic device,

where the electronic device is a hand portable electronic device.

Claim 1 is patentable over the art of record, whether taken singly or in combination, because the art of record does not teach each and every limitation of claim 1. In particular, it is not seen where in the combination of Herzig, Silverbrook and Schultheis there is either a description or suggestion of the emphasized subject matter of claim 1.

Herzig discloses a portable phone capable of reading a written identifier which may be a phone number, name etc. with an optical character recognition (OCR) scanner. The device uses the information obtained in this manner to, for example, dial a phone number. An example of this device is in reading a pictogram which is written on a substrate, e.g., paper. The pictogram could be, for example, an "information" symbol. After reading this symbol, the device may, for instance, dial the phone number for directory enquiries.

Claim 1 recites features directed to a reader and features directed to a writer. It is not seen where Herzig either describes or suggests the subject matter of claim 1 directed to a writer. The Examiner draws a parallel between some of the functionality of the reader and some of the functionality of the writer of claim 1. However, even when interpreted in this manner, Herzig fails to disclose “data output means” as required by claim 1.

Herzig fails to disclose a device capable of performing both the reading and writing functions. Herzig fails to disclose “data output means operable to output image data and associated metadata for generating a printed image on an image carrier, wherein the printed image carrier carried by the image carrier incorporates the metadata in a form readable by another electronic device” as recited by claim 1.

Silverbrook discloses a mobile phone capable of sending and receiving images and further comprises a printer to print the images. It fails to disclose metadata. Silverbrook fails to disclose: “data output means operable to output image data and associated metadata for generating a printed image on an image carrier, wherein the printed image carried by the image carrier incorporates the metadata in a form readable by the another electronic device” as required by claim 1.

Schultheis discloses a camera which is capable of reading pictures and capable of separately reading barcodes. The device then translates the barcode data into text and

connects the text to the picture in the camera's memory. It further transmits the picture and associated text to a PC where the picture and text are printed out. Schultheis fails to disclose "metadata means operable to generate metadata". As a result, it cannot disclose "data output means operable to output image data and associated metadata for generating printed image on an image carrier, wherein the printed image carried by the image carrier incorporates the metadata in a form readable by another electronic device" as recited by claim 1.

Accordingly, it is not seen in view of the foregoing where the art of record, whether taken singly or in combination, either describes or suggests a "data output means..." as required by claim 1.

Further, as discussed above, Herzig discloses a portable phone capable of reading a written identifier. There is no teaching or suggestion in Herzig that it would be desirable to incorporate a writing function into the device.

As Silverbrook does not teach the use of metadata, there is no motivation for a skilled person to incorporate the teaching of Silverbrook into that of Herzig.

The purpose of Schultheis is to produce a picture with corresponding text. Accordingly, the text is not for the purpose of storing information as metadata. There

would be no motivation for a skilled person to incorporate the teaching of Schultheis into that of Herzig or Silverbrook.

The remaining references relied upon in the rejection of the dependent claims do not remedy the deficiencies of the primary combination.

Accordingly, since the art of record neither describes nor suggests the combination of elements reflected in claim 1, Applicant submits that claim 1 is patentable and should be allowed. As a result, Applicant respectfully submits that the rejection of claim 1 be withdrawn. Applicant also submits that claims 3 – 17 and 22 – 42 are allowable both as depending, either directly or indirectly, on an allowable base claim, and for reasons having to do with their independently-recited features. Applicant therefore respectfully requests that the rejection of claims 3 – 13 and 22 – 42 be withdrawn.

III. Conclusion

The Applicant submits that in light of the foregoing remarks and amendments the application is now in condition for allowance. Applicant therefore respectfully requests that the outstanding rejections be withdrawn and that the case be passed to issuance.

Respectfully submitted,

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Date

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